

### REMARKS

Favorable reconsideration of this application, in light of the following remarks and discussion, is respectfully requested.

This Request for Reconsideration is in response to the Final Office Action mailed on September 9, 2005. Claims 1-5 and 16-33 are pending in the Application and stand rejected.

In the Office Action, Claims 1-5 and 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paley (U.S. Patent No. 1,971,164) in view of Jennings (U.S. Patent No. 4,079,859).

Applicants respectfully submit that Paley and Jennings, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in Claims 1 and 18. This is so because Paley teaches away from the proposed combination. “A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention”<sup>1</sup> and, furthermore, it “is improper to combine references where the references teach away from their combination.”<sup>2</sup>

The outstanding Office Action acknowledges that several features of the claimed invention are not taught or disclosed by Paley. In particular, it is acknowledged that Paley fails to disclose a collar extending beyond a cross section of the main container body. Jennings is cited as allegedly correcting the acknowledged deficiencies of Paley.

In Paley, as illustrated in all drawing illustrations of that patent, there is no inclination of the reading tube 19 with respect to the body portion 11. In addition, “the tube 19 and neck 17 are substantially wholly within the horizontal cross-sectional circular outline of the body 11. With this construction the bottle 10 may be readily fitted into the seat or container on the

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<sup>1</sup> MPEP § 2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

<sup>2</sup> M.P.E.P. §2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)).

centrifuging machine.”<sup>3</sup> In the second embodiment disclosed by Paley, “the outer rim 25 of the neck 17a, however, is disposed wholly within the circular outline of the body, as shown in FIG. 4 of the drawing.”<sup>4</sup> In fact, in the invention claimed, “said reading tube and inlet opening being wholly contained within the transverse circular outline of the body of the bottle.”<sup>5</sup>

The patentability standard for a case of obviousness requires that a reference be considered as a whole. “Portions arguing against or teaching away from the claimed invention must be considered.”<sup>6</sup> Applicants assert that, based on the above-summarized disclosure and claimed subject matter, Paley “would likely *discourage* the art worker from attempting the modification suggested by [the Office].”<sup>7</sup> Additionally, “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teaching of the prior art so that the claimed invention is rendered obvious . . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”<sup>8</sup>

If the container of Paley were to be modified as proposed by the Office, contrary to the specific teachings of that reference, the resulting modification would either not readily fit into the seat or container on the centrifuging machine (thus, rendering the modified container unsatisfactory for its intended use) or that machine would have to be substantially modified in order to accommodate a container comprising a reading tube and an inlet or mouth

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<sup>3</sup> Paley, page 1, lines 93-98.

<sup>4</sup> Paley, page 2, lines 25-28.

<sup>5</sup> Paley, Claim 1.

<sup>6</sup> *Bausch & Lomb, Inc. v. BarnesHind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986).

<sup>7</sup> *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990).

<sup>8</sup> *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

extending from the cross section of the bottle 13 (thus, requiring a substantial reconstruction and redesign). However, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified” or “the suggested combination of references would require a substantial reconstruction and redesign of the elements shown,” then there is no motivation to combine or modify the references.<sup>9</sup>

Applicants respectfully submit that there is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.

Applicants again restate that, with respect to the statement made about the finding of optimum values of result-effective variables, the cited case law is being incorrectly applied. It is well understood that a “particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”<sup>10</sup> Therefore, the statement that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to form the angle of the collar to the main container body and the secondary container body at about 120 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art,”<sup>11</sup> made in the outstanding Office Action is irrelevant, unless substantial evidence is found in the record supporting a conclusion that the claimed variables are “result-effective.” However, the record is devoid of such evidence.

Accordingly, Applicants respectfully submit that Paley and Jennings cannot support a prima facie case of obviousness of Claim 1 and 18. As to Claim 1, there is no motivation to

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<sup>9</sup> M.P.E.P. §2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

<sup>10</sup> See, for example, MPEP § 2144.05, citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

<sup>11</sup> See, Outstanding Office Action, page 3, item 5.

modify the container of Paley such that the collar extends beyond a cross section of the main body. As to Claim 18, there is no motivation to modify the container of Paley such that the main container body extends along its axis in a vertical direction, the collar extends along its axis at a first angle relative to the axis of the main container body, and the secondary container body extends along its axis at a second angle relative to the axis of the collar. Claims 2-5, 16, 17, and 19-33 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1 or Claim 18, which should be allowed as just explained.

In addition, Claims 2-5, 16, 17, and 19-33 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied references when those features are considered within the context of the subject matter recited in independent Claims 1 or 18.

As a non-limiting example, the outstanding Office Action is devoid of any explanation on how or where the following features are taught or disclosed in the cited references:

(1) as to Claim 2, said main container body comprises at least 20% of glass in the glass product;

(2) as to Claim 3, said main container body comprises at least 60% of glass in the glass product;

(3) as to Claim 4, said axis of said main container body and said axis of said collar form an angle between 60° and 180°;

(4) as to Claim 5, said axis of said main container body and said axis of said collar form an angle between 90° and 150°;

(5) as to Claim 19, the first and second angles are about equal;

(6) as to Claim 24, the main and secondary container bodies, and the collar are disposed in about Y-shape;

(7) as to Claim 27, the axis of the secondary container body is configured to extend at an angle of about 120° from the axis of the collar, such that the glass product has an about Y-shape;

(8) as to Claims 30 and 31, the product is a blown-blown glass product or a press-blown glass product; and

(9) as to Claims 31 and 32, the glass product has a single opening.

For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-5 and 16-33 is earnestly solicited.

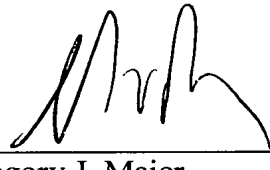
Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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